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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	79130383
Applicant	Flair Leisure Products Plc
Applied for Mark	PLASTICINE IMAGINE THE FUN!
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TRADEMARK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Flair Leisure Products Plc

Mark :



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Examining Attorney : Laura Golden

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APPLICANT'S REPLY BRIEF

TABLE OF CONTENTS

TABLE OF CONTENTS.....	i
TABLE OF AUTHORITIES	ii
INTRODUCTION	1
THE MARKS AT ISSUE ARE DIFFERENT IN APPEARANCE AND COMMERCIAL IMPRESSION	1
A. “IMAGINE THE FUN” is not the dominant portion of the mark’s appearance.....	1
B. “IMAGINE THE FUN” is not the dominant portion of the mark’s commercial impression	3
CONCLUSION.....	5
CERTIFICATE OF TRANSMISSION	6

TABLE OF AUTHORITIES


OTHER AUTHORITIES

<i>Ferro Corp. v. Ronco Labs., Inc.</i> , 356 F.2d 122, 124, 148 USPQ 497, 498-99 (CCPA 1966).....	2
<i>In re Covalinski</i> , 113 USPQ2d 1166 (TTAB 2014).....	2, 3
<i>In Re Don Calder, Inc.</i> Serial No. 85143799 (Trademark Trial and Appeal Board 2015)	3
<i>Parfums de Coeur Ltd. v. Lazarus</i> , 83 USPQ2d 1012 (TTAB 2007).....	2
<i>Recot, Inc. v. M.C. Becton</i> , 214 F.3d at 1329, 54 USPQ2d at 1897	1

STATUTES

15 U.S.C. Section 1052	1
TMEP §1207.01(b)	1



INTRODUCTION

The sole issue on appeal is whether there is a likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. Section 1052 between Applicant's mark  and registrant's prior-registered mark IMAGINE THE FUN. In the August 10, 2015 Examining Attorney's Appeal Brief, the Examining Attorney failed to address key issues and case law raised by the Applicant. Rather, the Examining Attorney repeated her circular reasoning that the marks share a common phrase IMAGINE THE FUN and convey the same commercial impression. Applicant maintains that the relevant facts pertaining to the appearance and connotation of these two marks has been skewed in this case. Applicant respectfully requests the Trademark Trial and Appeal Board to reverse the Examining Attorney's decision on the grounds that Applicant's mark does not create a likelihood of confusion with the mark cited by the Examining Attorney.

THE MARKS AT ISSUE ARE DIFFERENT IN APPEARANCE AND COMMERCIAL IMPRESSION


TMEP §1207.01(b) states: "[w]hen considering the similarity of the marks, '[a]ll relevant facts pertaining to the appearance and connotation must be considered.' *Recot, Inc. v. M.C. Becton*, 214 F.3d at 1329, 54 USPQ2d at 1897. Applicant maintains that the Examining Attorney did not consider all of these factors in finding a likelihood of confusion.

A. "IMAGINE THE FUN" is not the dominant portion of the mark's appearance


Applicant steadfastly maintains that the tagline "IMAGINE THE FUN" is not the dominant portion of the mark. Rather, the dominant portion of Applicant's mark is , as well as the overall design of the mark , including the red background, colorful text, and

thought bubbles. The Examining Attorney dismissed this argument in her appeal brief without any concrete reason.


Applicant had identified both precedential and non-precedential opinions by the Board in which the whole of a registrant's mark was included in an applicant's mark and the addition of a design feature served to distinguish the marks to the satisfaction of the Board. For example in *In*


re Covalinski, 113 USPQ2d 1166 (TTAB 2014), the marks were RACEGIRL and 

(two stylized Rs one spelling Redneck and the other spelling Racegirl). The Board acknowledged that the marks contained some of the same words, but ultimately held that the two marks were too visually distinct from one another for a likelihood of confusion to occur. The facts in *Covalinski* mirror the current issue. Just because some words from a mark appear in another trademark does not automatically indicate a likelihood of confusion result. Similar to the

Covalinski reasoning, the words IMAGINE THE FUN are difficult to notice in Applicant's  mark and are not the portion of the mark that is impressed on the consumer.


In addition, the Applicant cited a list of cases where the Board found that the design feature of a mark was considered to be dominant not unlike the instant case. *Ferro Corp. v. Ronco Labs., Inc.*, 356 F.2d 122, 124, 148 USPQ 497, 498-99 (CCPA 1966). In *Ferro Corp.*,

the applicant's  mark was at issue, while the opposer owned several marks consisting of or containing FERRO. The Board found confusion unlikely due to the dominance of the design elements of the applicant's mark and the relatively small typeface in which FERRO appeared. Similarly in *Parfums de Coeur Ltd. v. Lazarus*, 83 USPQ2d 1012 (TTAB 2007) the

 Board found the prominently displayed **BODYMAN** design to be a dominant element of the mark because it catches the eye and engages the viewer before the viewer looks at the word Bodyman.


The Examining Attorney entirely dispensed Applicant's argument in the appeal brief without ever discussing why. In fact the *Covalinski* case is never even once mentioned in the Examining Attorney's appeal brief.

B. "IMAGINE THE FUN" is not the dominant portion of the mark's commercial impression

In the August 10, 2015 Examining Attorney's Appeal Brief, the Examining Attorney stated: "[t]he only difference in the wording between registrant's IMAGINE THE FUN mark and applicant's PLASTICINE IMAGE THE FUN MARK  is the addition of applicant's house mark. The addition of this house mark does distinguish the marks, but rather makes it more likely that consumers will believe there to be an association between the goods and services sold under the marks." This is not the case.


After submission of the Examining Attorney's appeal brief, Applicant has found more non-precedential cases citing the *Covalinski* ruling. The Examining Attorney failed to discuss *In Re Don Calder, Inc.* Serial No. 85143799 (Trademark Trial and Appeal Board 2015), one of the most recent cases that addresses this exact issue. In *In Re Don Calder, Inc.*, the marks at



issue were  (Republic of Kalifornia written under the bear graphic) and California Republic. The *Don Calder* case cites to the *Covalinski* ruling for the principle that a design element, here the bear, may dominate a Registrant's mark. The Board found that the, "design and wording REPUBLIK OF KALIFORNIA work together to create the overall commercial impression described as a former Soviet state, such that the wording does not dominate the design." Similarly here, the applicant's slogan, thought bubbles and colorful text enhance the notion that when using the PLASTICINE craft and hobby kits products, a person can create

anything that comes to his or her imagination. This mark is used on craft and hobby kits which by their very nature engage the user's imagination. By contrast, the cited mark lacks any development of the imagination or creativity theme. The overall commercial impression created by the marks is entirely different.



The Examining Attorney states, "[t]he IMAGINE THE FUN wording identifies registrant's retail store services, just as the phrases JUST DO IT, THE HAPPIEST PLACE ON EARTH . . . identify the source of particular goods and services, even when used separately from the relevant brands." The Applicant reiterates that consumers are highly unlikely to call for a product

by the phrase IMAGINE THE FUN. When viewing the  trademark, the most obvious features to stand out and remembered in a consumer's mind is the bright, red background, thought bubbles, and colorful lettering **Plasticine** – the overall look of the mark. The remainder of Applicant's mark is laudatory and merely a weak tagline. Applicant's mark, IMAGINE THE FUN is most definitely an afterthought, not what sticks in the consumer's mind. Furthermore, the Examining Attorney relies on three cases in this section of her argument, none of which are to be considered precedent by the TTAB.

Finally, the Examining Attorney states that the "[a]pplicant focuses its arguments largely on the examining attorney's purported argument that IMAGINE THE FUN is the dominant element of applicant's mark. This misstates the examining attorney's position. Rather, the refusal rests on the use of this phrase as a separable element of applicant's mark, namely, a slogan associated with the brand name." Not so. Applicant unwaveringly believes a tagline's lack of dominance in the entirety of the mark is a crucial part of this entire analysis. The applicant's mark is dominated by its already registered product line mark, PLASTICINE. The "IMAGINE THE FUN" phrase is merely a slogan coupled to Applicant's product line mark. It is not the name of the actual services, because indeed the Applicant provides no services. Given the later placement of the phrase in the mark and its descriptive nature, it is highly unlikely that

the Applicant or any consumer will use the slogan without any reference to their product line mark PLASTICINE already registered since 2009.

CONCLUSION

The only remaining issue preventing registration of Applicant's  mark relates to the alleged likelihood of confusion with the prior registration for IMAGINE THE FUN. When considered in its entirety, the  mark conveys a different overall impression from the IMAGINE THE FUN mark. The two marks are entirely different in sound, appearance and meaning and present an entirely different commercial impression. Moreover, the Examining Attorney in the appeal brief dismissed that the IMAGINE THE FUN tagline as a dominant portion of the overall mark. However, the slogan is merely a weak, laudatory tagline. Thus, the Applicant submits that there is no likelihood of confusion between the marks.

Applicant respectfully request that the Board reverse the Examining Attorney's refusal under Section 2(d) and permit registration of the  mark on the Principal Register.

Respectfully submitted,

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CERTIFICATE OF TRANSMISSION

I hereby certify that the foregoing *Applicant's Reply Brief* has been filed electronically on August 31, 2015.



Colleen Flynn Goss